IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 06-278)

In the Application of:	)	
	)	
John Hillel Moshal	)	Art Unit: 3714
	)	
Serial No.: **10/576,743**	)	
	)	Examiner: Lim, Heng Seng
Filed: **January 9, 2007**	)	
	)	
Title: **Redundant Gaming System**	)	Confirmation No. 8207

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW PREMATURE DESIGNATION OF FINALITY

Dear Sir:

Pursuant to 37 C.F.R. § 1.181, Applicant hereby petitions the Office to withdraw the designation of finality in the Office Action mailed November 24, 2008 as being premature. *See* MPEP §§ 706.07(c) and 1002.02(c). In support, Applicant states as follows:

Background

1. On November 15, 2007, an Office Action was mailed that rejected all pending claims (i.e., claims 1-25) in the above-referenced application. The rejections were based on references identified as Sakamoto, Pease, and Crumby.

2. On February 8, 2008, Applicant filed a Response that canceled claims 1-25 and added new claims 26-40. The Response also explained how claims 26-40 were patentable over the cited references (Sakamoto, Pease, and Crumby).

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3. On April 24, 2008, an Office Action was mailed that rejected the new claims 26-40 based on the same references (Sakamoto, Pease, and Crumby). The Examiner designated this Office Action as final, arguing that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action."

4. On July 16, 2008, Applicant filed a Notice of Appeal with a Pre-Appeal Brief Request for Review. The Pre-Appeal Brief Request included Applicant's "Reasons for Review of Final Rejection" that set forth reasons why the Examiner's claim rejections were clearly erroneous.

5. On September 16, 2008, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed. The Notice stated: "The rejection is withdrawn and a new Office Action will be mailed." Thus, the Panel decided to reopen prosecution, confirming that the rejections set forth in the Office Action mailed April 24, 2008 were clearly erroneous.

6. On November 24, 2008, an Office Action was mailed that again rejected claims 26-40, but based on new grounds. Specifically, the rejections were based on a new set of references, identified as Coile, Holch, and Duncombe. The Office Action was designated final. According to the Office Action, the designation of finality was justified by the amendment filed on 2/28/2008. In fact, however, the new Office Action was necessitated by the Panel's decision, not by any amendment.

7. The undersigned contacted the Examiner by telephone and explained that the Office Action mailed November 24, 2008 should not be designated final because it was not necessitated by amendment. The Examiner refused to withdraw the designation of finality, arguing that it was justified by MPEP § 1207.04.

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Argument

"Under present practice, second or subsequent actions shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement." *See* MPEP § 706.07(a). In this case, the Office Action mailed November 24, 2008 contains new grounds of rejections. However, the new grounds of rejections are not necessitated by any amendment of the claims by Applicant or by any information submitted in an information disclosure statement. The 2/28/2008 amendment may have necessitated new grounds of rejection in the Office Action mailed April 24, 2008, but that amendment certainly did not necessitate the new grounds of rejection in the Office Action mailed November 24, 2008. Instead, the Office Action mailed November 24, 2008 was necessitated by the Panel's decision to reopen prosecution. In other words, the new grounds of rejection in the Office Action mailed November 24, 2008 were necessitated by the fact that the grounds of rejection in the previous Office Action were clearly erroneous. Therefore, the Office Action mailed November 24, 2008 should not be designated final.

The Examiner's reliance on MPEP § 1207.04 is unavailing. That section allows an examiner to "reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed." But Applicant has not filed any appeal brief. Therefore, MPEP § 1207.04 simply does not apply. Moreover, MPEP § 1207.04 states that "[t]he Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement." Again, the new grounds of rejection in the Office Action mailed November 24, 2008 were not necessitated by amendment or by information presented in an information disclosure

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statement. Instead, the new grounds of rejection were necessitated by the fact that the previous grounds of rejection were clearly erroneous, as indicated by the Panel's decision to reopen prosecution.

Accordingly, the designation of finality in the Office Action mailed November 24, 2008 is premature. Applicant respectfully requests that the premature designation of finality be withdrawn.

Respectfully submitted,

Date: January 30, 2009

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